

REMARKS

In response to the Office Action dated September 11, 2006, Applicants submit the following response. Claim 1 has been amended. Support for the amendment may be found at paragraph [0050]. Reconsideration of the grounds of rejection is respectfully requested in view of the amendments and remarks herein.

Summary of the Office Action

The Examiner has objected to the specification under 37 C.F.R. § 1.75(d)(1) for failure to provide proper antecedent basis for claimed subject matter.

The Examiner has objected to paragraphs [0005], [0009], [0054] and [0067] for informalities.

The Examiner has objected to claims 5, 6, 9 and 25 for informalities.

Claims 1, 6, 9, 11, 12 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publ. No. 2004/0138067 ("Rayborn") in view of U.S. Patent No. 5,807,811 ("Malchow"), U.S. Patent No. 5,700,767 ("Adams") and U.S. Patent No. 6,451,953 ("Albright").

Claims 1-9 and 11-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rayborn in view of U.S. Patent No. 4,636,323 ("Makino"), Adams and Albright.

Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Rayborn in view of Malchow or Makino Adams, Albright and U.S. Patent No. 5,213,697 ("Vinci").

Claims 25 and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rayborn in view of Malchow or Makino, Adams, Albright and U.S. Patent No. 3,756,315 ("Suman").

Claims 22 and 27-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rayborn in view of Malchow or Makino, Adams, Albright and U.S. Patent No. 5,883,054 ("Hernandez")

Response to Office Action

A. Objection to the Specification

With regards to the claim limitation of “reactable with at least one carboxylic acid moiety in the unsaturated fatty acid,” the Applicant respectfully asserts that the phrase constitutes a part of the specification as it is contained within an original claim.

Where subject matter not shown in the drawing or described in the description is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter. The claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and description. It is the drawing and description that are defective, not the claim. MPEP § 608.01(I).

The Applicant has amended the specification at paragraph [0053], to reflect this limitation.

Regarding the Examiner’s objections to paragraphs [0005], [0009], [0054] and [0067], the Applicant has amended the paragraphs to correct the informalities.

The Applicant respectfully requests the entering of these amendments into the Specification and withdrawal of the Examiner’s objections to the Specification.

B. Objections to claims 4, 5, 9 and 25

Regarding the Examiner’s objections to claims 4, 5, 9 and 25, the Applicant has amended the claims to correct the informalities.

The Applicant respectfully requests the entering of these amendments and withdrawal of the Examiner’s objections to the claims.

C. Rejection of Claims 1, 6, 9, 11, 12 and 13 under 35 U.S.C. § 103(a)

In response to the Examiner’s rejection of claims 1, 6, 9, 11, 12 and 13, the Applicant respectfully asserts that the pending claims are allowable over the cited references because the Examiner has failed to establish a *prima facie* case of obviousness. The MPEP states, in relevant part:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a

reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. MPEP § 2142.

The Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for the reasons discussed below.

1. The combination of Rayborn, Malchow, Adams and Albright fails to disclose each and every element of independent claim 1.

Claim 1 provides for a lubricant composition. The composition includes a film forming lubricant consisting essentially of unsaturated fatty acid(s) having between 16 and 26 carbon atoms and between one and three carboxylic acid moieties. Applicant respectfully asserts that Rayborn does not disclose the underlined claim element.

The Examiner has cited paragraph [0012] for disclosing corn oil and soybean oil. These oils are excluded from claim 1 which is limited to a film forming lubricant consisting essentially of unsaturated fatty acids. It is well known to those of skill in the art that corn oil contains up to 13 percent saturated fatty acids, soybean oil contains up to 14 percent saturated fatty acids and peanut oil contains up to 14 percent saturated fatty acids. The additional oils disclosed by Rayborn, hydrocarbon oil, mineral oils, paraffin oils, synthetic oils and diesel oils also contain saturated fatty acids.

The composition may also include a film forming lubricant consisting essentially of triglyceride(s) having one or more fatty acids, each fatty acid having from 16 to 26 carbon atoms and at least one double bond. Applicant respectfully asserts that Malchow does not disclose the underlined claim element.

The Examiner has cited Malchow at Col. 4, lines 18-32 as disclosing a composition of triglycerides. The fatty acids disclosed by Malchow include “aliphatic hydrocarbon groups; that is, alkyl groups such as heptyl, nonyl, decyl . . .”. Col. 4, lines 36-37. These triglycerides are excluded from claim 1 which is limited to a film forming lubricant consisting essentially of triglycerides having unsaturated fatty acids as part of the triglyceride.

Therefore, Rayborn and Malchow, alone or in combination, fail to disclose the film forming lubricant required in amended claim 1.

2. The Examiner has failed to establish a suggestion or motivation to combine Rayborn and Adams

The Applicants respectfully submit that the Examiner has failed to establish a suggestion or motivation to combine Rayborn and Adams as the proposed modification renders the invention of Rayborn unsatisfactory. When the proposed combination would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed combination. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

Rayborn disclosed a drilling fluid additive fluid system. ¶ [0012] One of the stated advantages is to enhance “the surface and the thickness of the wall cake.” ¶ [0024] One of skill in the art will understand that “wall cake” refers to the solid deposited along the hole wall while the fluid part of the drilling mud flows into the formation.

In contrast, Adams discloses a lubricant having a filming amine. The amine “has an affinity for metal and effectively coats metal in the well.” Col. 1, lines 43-44. Adams further states when the lubricant is added to water based drilling fluid, “the lubricant disperses but shortly coats the metal surfaces in the well.” Col. 1, lines 451-52.

The combination proposed by the Examiner would prevent the lubricant of Rayborn from performing its intended function of enhancing wall cake thickness as the lubricant would instead coat the metal surfaces not the wall cake.

Therefore, Adams is not properly combined with Rayborn and there can be no motivation to combine these two references.

For these reasons and those discussed in section C.1, independent claim 1 is patentable.

3. Dependent claims 6, 9, 11, 12 and 13

Dependent claims 6, 9, 11, 12 and 13 depend directly or indirectly on independent claim 1. Therefore, for the reasons noted above, claims 6, 9, 11, 12 and 13 are allowable because they depend from an allowable base claim 1.

D. Rejection of Claims 1-9 and 11-24 under 35 U.S.C. § 103(a)

The Applicant asserts the combination of Rayborn, Makino, Adams and Albright fails to disclose each and every element of claims 1-9 and 11-24.

1. The combination of Rayborn, Makino, Adams and Albright fails to disclose each and every element of independent claim 1.

As discussed above, Rayborn fails to disclose each and every element of independent claim 1. Applicant asserts that Makino fails to make up for this deficiency.

Makino describes a lubricating oil composition including “animal and vegetable fats and oils include tallow, lard, rapeseed oil, coconut oil, palm oil, rice bran oil, their hydrogenated products.” Col. 2, lines 36-38. The oils may include saturated and unsaturated fatty acids having 12 to 24 carbon atoms. Col. 2, lines 41-43.

Applicant asserts that Makino does not disclose a composition consisting essentially of an unsaturated fatty acid. Makino states the fatty acid may be a saturated fatty acid. Furthermore, one of skill in the art will know that tallow, lard, coconut oil and palm oil are saturated fatty acids or include saturated fatty acids.

Claim 1 is therefore patentable for the reasons discussed here and above in section C.

2. Claims 14 and 15

Claims 14 and 15 require that the lubricant composition, of claim 1, comprises less than 2 wt.% and 1 wt.%, respectfully, of each of the following: promoters useful for forming the overbased film forming lubricant/suspension agent composition; resin acids; unsaponifiables; and saturated fatty acids and their isomers.

The Examiner states that Rayborn does not disclose small amounts of these impurities so it would be obvious for a lubricant composition to contain less than 2 wt.% or 1 wt.% of the impurities. Applicant respectfully disagrees with this statement.

The carrier of Rayborn includes oils having significant amounts of saturated fatty acids. For example, corn oil contains up to 13 percent saturated fatty acids, soybean oil contains up to 14 percent

saturated fatty acids and peanut oil contains up to 14 percent saturated fatty acids. As Rayborn does disclose a lubricant composition containing saturated fatty acids, it would not be obvious for a lubricant composition to contain the elements of claims 14 and 15. Therefore for the reasons discussed here and in sections C and D1, dependent claims 14 and 15 are patentable.

3. Dependent claims 2-24

Dependent claims 2-24 depend directly or indirectly on independent claim 1. Therefore, for the reasons noted above in C, D1 and D2, claims 2-24 are allowable because they depend from an allowable base claim 1.

E. Rejection of claim 10 under 35 U.S.C. § 103(a)

For the reasons discussed above in sections C and D, which are incorporated by reference to this section, the Applicant asserts the combination of Rayborn, Malchow or Makino, Adams, Albright and Vinci fails to disclose each and every element of dependent claim 10.

F. Rejection of Claims 25 and 26 under 35 U.S.C. § 103(a)

For the reasons discussed above in sections C and D, which are incorporated by reference to this section, the Applicant asserts the combination of Rayborn, Malchow or Makino, Adams, Albright and Suman fails to disclose each and every element of dependent claims 25 and 26.

G. Rejection of Claims 22 and 27-29 under 35 U.S.C. § 103(a)

For the reasons discussed above in sections C and D, which are incorporated by reference to this section, the Applicant asserts the combination of Rayborn, Malchow or Makino, Adams, Albright and Hernandez fails to disclose each and every element of dependent claims 22 and 27-29.

CONCLUSION

In view of the foregoing remarks, it is submitted that pending claims 1-29 are in condition for allowance. Accordingly, reconsideration and timely allowance of claims 1-29 are requested.

Applicant respectfully requests reconsideration and withdrawal of the rejection based on 35 U.S.C. § 103(a) presented in the Office Action mailed September 11, 2006. The Examiner is invited to contact the undersigned at 215-963-5055 to discuss any matter concerning this Application.

The Commissioner is hereby authorized by this paper to charge any fees due in connection with the filing of the response to Deposit Account No. **50-0310**.

Respectfully submitted,

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Date

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